

REMARKS

Claims 14-20 were pending in this application. Applicants have carefully considered the March 10, 2005 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 14-20 were pending in this application. In response to the Office Action dated March 10, 2005, claims 19 and 20 have been canceled and Figure 1 has been amended. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification. Applicants submit that the present Amendment does not generate any new matter issue. Entry of the present Amendment is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

Applicants submitted an Information Disclosure Statement (IDS) at the time of filing the present application (April 12, 2004). There was no indication that this IDS was considered by the Examiner. The Examiner is respectfully requested to consider the IDS and forward Applicants an appropriately initialed copy of PTO form 1449 in the next Office communication.

The Examiner objected to the drawings under 37 CFR 1.83(a) because FIG. 1 does not include a "Prior Art" legend. In response to the objection, FIG. 1 has been amended to include a "Prior Art" legend. A single replacement page accompanies this Amendment. In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the drawing objection.

The specification was objected to because it allegedly did not include a Brief Description of the Drawings section. Applicants respectfully traverse the objection and direct the Examiner's attention to pages 14-15 of the present specification, wherein a Brief Description of the Drawings is present for all of drawing figures 1-3(c). Accordingly, Applicants respectfully request reconsideration and withdrawal of the objection to the specification.

Claims 14-17 were rejected under 35 U.S.C. § 112, second paragraph. Applicants respectfully traverse the rejection.

Indefiniteness under the second paragraph of 35 U.S.C. § 112 is a question of law. *Tillotson Ltd. v Walbro Corp.*, 4 USPQ 2d 1450 (Fed. Cir. 1987). Accordingly, in rejecting a claim under the second paragraph of 35 U.S.C. § 112, the PTO is required to discharge its initial burden for providing a basis in fact and/or cogent reasoning to support the ultimate legal conclusion that one having ordinary skill in art, with the supporting specification in hand, would not be able to reasonably ascertain the scope or protection defined by the claim. *In re Cortwright*, 165 F.3d 1353, 49 USPQ 2d 1464 (Fed. Cir. 1999). Consistent judicial precedent holds that reasonable precision in light of the particular subject matter involved is all that is required by the second paragraph of 35 U.S.C. § 112. *Miles Laboratories, Inc. v. Shandon, Inc.*, 27 USPQ 2d 1123 (Fed. Cir. 1993); *North American Vaccine, Inc. v. Amercian Cyanamide Co.*, 28 USPQ 2d 1333 (Fed. Cir. 1993); *U.S. v. Telectronics, Inc.*, 8 USPQ 2d 1217 (Fed. Cir. 1988). Applicant stresses that a patent specification must be viewed through the eyes of one having ordinary skill in the art. *Miles Laboratories, Inc. v. Shandon, Inc.*, *supra*.

In applying the above legal tenets to the exigencies of this case, Applicant submits that one having ordinary skill in the art would not have been befuddled by the use of the following preamble: "A structure for use in the manufacture of a patterned thin film magnetic recording medium",

particularly as employed in the context of the claimed subject matter. Applicants further submit that the Examiner's proposed language to recite a "servo-patterned thin film magnetic medium" does not accurately reflect the subject matter involved in claims 14-17. Rather, the claims 14-17 recite a structure that can be implemented into a magnetic recording medium. Thus, the structure recited is an intermediate product and not a completed servo-patterned magnetic recording medium, as recited in claim 18. Accordingly, one having ordinary skill in the art would not have difficulty understanding the scope of the presently claimed invention, particularly when reasonably interpreted in light of the supporting specification. The Examiner provided no arguments to justify why one having ordinary skill in the art would have had difficulty understanding Applicant's claimed invention. Therefore, it is respectfully submitted that the imposed rejection of claims 14-17 under 35 U.S.C § 112, second paragraph is not legally viable and hence, solicit withdrawal thereof.

Claims 19 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang et al. (U.S. Pat. No. 6,746,754) in view of Wang et al. (U.S. Pat. No. 6,623,788). Claims 19-20 have been cancelled and, therefore the rejection is moot.

Claims 19 and 20 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable of claims 1, 3, 5 and 6 of Wang et al. (U.S. Pat. No. 6,746,754) alone, or in view of the teachings of Wang et al. (U.S. Pat. No. 6,623,788). Claims 19-20 have been cancelled and, therefore the rejection is moot.

Applicants note the Examiner's Statement of Reasons for Allowance included on pages 8-9 of the Office action. Entry of that Statement into the record should not be construed as any agreement with or acquiescence by Applicants in the reasoning stated by the Examiner. Applicants positions on the issues appear in Applicants' response. The Statement of Reasons for Allowance should not be used to interpret the cited claims, particularly to the extent if any that the Statement of

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Reasons for Allowance may differ from the express language of the claims and/or Applicants' positions on patentability of those claims. It is respectfully submitted that the allowed claims should be entitled the broadest reasonable interpretation and broadest range of equivalents that are appropriate in light of the language of the claims, the supporting disclosure and Applicants' prosecution of the claims, without reference to the Statement of Reasons for Allowance.

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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AMENDMENTS TO THE DRAWINGS

The attached single (1) drawing sheet includes changes to Figure 1. The single sheet replaces the original sheet containing Figure 1. The label "Prior Art" has been added to Figure 1.